

## RESPONSE TO OFFICE ACTION

### A. Status of the Claims

Claims 1, 2, 4-8, 10-14, and 30-35 were under examination at the time of the Action. Claim 14 is canceled without prejudice. Claim 31 is amended to more clearly claim the Applicants' invention. Support for this amendment is found at Example 8. No new matter is added. Claims 1, 2, 4-8, 10-13, and 30-35 are pending and presented for reconsideration.

### B. Claim Objections

The Action objected to claims 34-35 as depending from a rejected claim. Applicant has amended claim 31 to remove the term "about" from the phrase "about 30°C." In view of the foregoing, the rejection is believed to be moot and its withdrawal is respectfully requested.

### C. Rejection of Claim Under 35 U.S.C. §102(b)

Claim 14 is rejected under 35 U.S.C. §102(b) as being anticipated by Smeekens *et al.*, 1999 (U.S. Patent 5,986,173). In view of the cancellation of claim 14, this rejection is believed to be moot, and its withdrawal is respectfully requested.

### D. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement

The Action rejects claims 1-2, 4-8, 10-13, and 30-33 as lacking enablement. In particular, the Action asserts that the specification does not reasonably provide enablement for a single selection temperature. Applicants respectfully traverse in part, while noting that claim 31 is amended herein.

Regarding claim 1 and claims dependent therefrom, M.P.E.P. 2164.02 states that "Proof of enablement will be required for other members of the claimed genus only where adequate reasons are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation.," while M.P.E.P. 2164.04 states that the

Examiner has the initial burden to establish a reasonable basis to question enablement, and to provide specific technical reasons to doubt enablement. Applicants submit that such reasons are not provided by the Action. Applicants also respectfully note that this enablement rejection relating to “dual selection steps” was asserted more than four years after the filing of the Application, which is not in accord with principles of compact prosecution.

Applicants respectfully submit that the Action provides no reasoning to support the apparent assertion that dual selection temperatures are required in order to achieve the benefit of enhanced transformation efficiency, and Applicants respectfully submit that the Action is mistaken in understanding that the Specification teaches this. Instead, Applicants respectfully submit that a period of selection at an elevated temperature provides the benefit. Applicants also point to M.P.E.P. 2164.08(c):

**2164.08(c) Critical Feature Not Claimed**

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

In particular, Applicants submit that the Action, at least implicitly, apparently asserts that multiple (*e.g.* dual) selection temperature steps are a critical feature of the invention, yet the disclosure does not teach this to be the case, and it is entirely unclear how this reasoning of the Action has arisen, or the basis for it. Rather, in certain embodiments of the invention, periods of

selection at different temperatures may be utilized, *e.g.* dual selection temperatures, while in other embodiments a selection step at an elevated temperature may be utilized.

As stated in the Specification at paragraph [0009]: “...an elevated temperature for a period of time sufficient to identify and select transformed plants..”; or at paragraph [0019], “...maintaining the temperature during the selection phase, or at least a portion of the selection phase, at a temperature greater than 27°C ...,” embodiments are described that contemplate a single temperature selection step, at an elevated temperature. That is, a length of time at an elevated temperature, and not two selection temperatures *per se*, is contemplated as providing benefit. Further, a period of up to three weeks at an elevated selection temperature is contemplated at paragraph [0019], while Example 8, paragraph [0100] for instance, indicates a total selection time of three weeks. Thus, the Specification clearly contemplates embodiments comprising one or more selection temperatures, and the Action provides no basis for the assertion that dual (or multiple?) selection temperatures are required. Withdrawal of the rejection of claims 1, 2, 4-8, 10-13, and 30-33, as lacking enablement under 35 U.S.C. §112, First Paragraph, is respectfully requested.

Regarding claim 31 and claims dependent there from, Applicants respectfully note that claim 31 explicitly recites “...the second temperature is lower than the first temperature...” as amended in the prior response. The plain meaning of claim 31 indicates that first and second temperatures are recited, *e.g.* dual selection temperatures, and that these temperatures are distinct from each other. Although the Action at the bottom of page 4 asserts that the claims, including claims 31-33, omit the second selection period, Applicants respectfully submit that this is mistaken, as at least claims 31-33 clearly relate to a transformation method comprising dual selection temperatures. Thus withdrawal of the rejection of at least claims 31 and 34-35 as

lacking enablement under 35 U.S.C. §112, First Paragraph in the Action at the paragraph bridging pages 4-5 is respectfully requested.

Further however, only in order to advance prosecution, claim 31 is amended as suggested in the Action to remove “about” from the phrase “...about 30°C...” Thus, the rejection of claim 31 as lacking enablement, in view of the first full paragraph on page 5 of the Action, is believed to be moot, and its withdrawal is respectfully requested.

### **CONCLUSION**

In view of the foregoing, Applicants respectfully request favorable consideration of this case. The Examiner is invited to contact the undersigned attorney at (214) 259-0931 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: June 19, 2009